

The opinion in support of the decision being entered today was *not* written for publication in and is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte THOMAS THOROE SCHERB and HARALD SCHMIDT-HEBBEL

MAILED

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U.S. PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Appeal No. 2006-2066
Application No. 10/743,461
Technology Center 1700

HEARD: October 17, 2006

Before OWENS, WALTZ, and GAUDETTE, *Administrative Patent Judges*.

OWENS, *Administrative Patent Judge*.

DECISION ON APPEAL

This appeal is from a rejection of claims 1-33, which are all of the pending claims.

THE INVENTION

The appellants claim a machine for manufacturing a fiber material web, particularly tissue paper or a hygienic paper web. Claim 1 is illustrative:

1. A machine for the manufacture of a fiber material web, comprising:
a shoe pressing unit;

a cylinder comprising a Yankee drying cylinder, said shoe pressing unit and said cylinder being arranged to form at least one press nip;

a water absorbent carrier band;

a water-impermeable pressing band, wherein said water absorbent carrier band and said water-impermeable pressing band are guided through said at least one press nip, and the fiber material web is adapted to pass through said at least one press nip with said water absorbent carrier band and said water-impermeable pressing band; and

said at least one press nip has a length in a web travel direction greater than approximately 80 mm,

wherein said shoe press unit, said cylinder, said water absorbent carrier band and said water-impermeable pressing band are structured and arranged so that a pressure profile which results over the press nip length has a maximum pressing pressure which is less than or equal to approximately 2 MPa, and

wherein said shoe press unit, said cylinder, said water absorbent carrier band and said water-impermeable pressing band are structured and arranged for the formation of one of a tissue paper and a hygienic paper web.

THE REFERENCES

Tapio et al. (Tapio)	4,139,410	Feb. 13, 1979
Sauer	5,019,211	May 28, 1991
Laapotti	5,043,046	Aug. 27, 1991
Bluhm et al. (Bluhm)	5,556,511	Sep. 17, 1996
Edwards et al. (Edwards)	6,248,210	Jun. 19, 2001

THE REJECTIONS

The claims stand rejected as follows: claims 1-4, 7-21 and 24-32 under 35 U.S.C. § 102(e) as anticipated by Edwards; claims 5 and 6 under 35 U.S.C. § 103 as obvious over Edwards in view of Laapotti; claims 22 and 23 under 35 U.S.C. § 103 as obvious over Edwards in view of Bluhm and Tapio; and claim 33 under 35 U.S.C. § 103 as obvious over Edwards in view of Sauer.

OPINION

We reverse the aforementioned rejections, enter a new rejection of claim 1 under 37 CFR § 41.50(b), and remand the application to the examiner to address the other claims.

We need to discuss only the examiner's rejection of the sole independent claim, i.e., claim 1. The examiner does not rely upon any of the other references for a disclosure or suggestion of subject matter in that claim. Claim 1 requires at least one press nip between a shoe pressing unit and a Yankee drying cylinder, wherein the at least one press nip has a length in a web travel direction greater than approximately 80 mm (3.15 inches) and has a pressure profile over its length having a maximum pressing pressure less than or equal to approximately 2 MPa.

Edwards discloses a shoe pressing unit in combination with a transfer cylinder that can be a Yankee cylinder (col. 15, lines 59-64; col. 16, lines 26-27) having between them a press nip wherein "[t]he shoe element length can be less than about 7 inches but is more preferably less than about 3 inches" (col. 16, lines 43-45) and "the peak pressure in the shoe press is preferably greater than about 2000 kN/m² [2 MPa]" (col. 17, lines 1-3).

The examiner has the initial burden of establishing a prima facie case of anticipation by pointing out where all of the claim limitations appear in a single reference. See *In re Spada*, 911 F.2d 705, 708, 15 USPQ2d 1655, 1657 (Fed. Cir. 1990); *In re King*, 801 F.2d 1324, 1327, 231 USPQ 136, 138-39 (Fed. Cir. 1986).

The examiner points out that Edwards' figure 3 shows a nip load of about 1.5 MPa for a 120 mm typical shoe, and figure 12 discloses cold Yankee cylinder solids for a 120 mm conventional shoe (answer, page 5). Thus, the examiner argues, Edwards discloses each element of the claimed invention (answer, pages 5-6).

Edwards' disclosure that the counter roll in a conventional shoe press is small compared to a Yankee dryer (col. 5, lines 58-60) indicates that the counter roll used with the typical shoe in figure 3 is not a Yankee cylinder. The counter roll used with the 120 mm conventional shoe in figure 12 is a Yankee cylinder, but Edwards does not disclose the maximum pressing pressure the combination is capable of providing.

Thus, to arrive at the claimed invention, one must pick, in combination with the conventional 120 mm shoe, the nip load from figure 3 and the Yankee cylinder from figure 12. For the claimed invention to be anticipated, the reference must lead one

of ordinary skill in the art to the recited combination of elements "without any need for picking, choosing, and combining various disclosures not directly related to each other by the teachings of the cited reference." *In re Arkley*, 455 F.2d 586, 587, 172 USPQ 524, 526 (CCPA 1972). Because the examiner's rationale requires such picking and choosing, the examiner has not carried the burden of establishing a prima facie case of anticipation of the claimed invention by Edwards.

Nor has the examiner explained why the combination of shoe press, Yankee cylinder, press nip length and maximum pressing pressure would have been fairly suggested to one of ordinary skill in the art by Edwards. Thus, with respect to the dependent claims rejected over Edwards in combination with other references, the examiner has not established a prima facie case of obviousness.

We therefore reverse the examiner's rejections under 35 U.S.C. §§ 102(e) and 103.

New ground of rejection

Under the provisions of 37 CFR § 41.50(b) we enter the following new rejection.

Claim 1 is rejected under 35 U.S.C. § 103 as being unpatentable over Edwards.

Edwards discloses a shoe pressing unit in combination with a counter roller that can be a Yankee cylinder that form a nip between them through which a fiber material web passes (col. 15, lines 59-64; col. 16, lines 26-27; figure 12). The fiber material web passed through the nip can be on a combination of a water absorbent carrier band and water-impermeable pressing band (col. 3, lines 57-59; col. 11, lines 40-42). The shoe element length can be less than about 7 inches (col. 16, lines 43-45). That range overlaps the appellants' recited range of greater than approximately 80 mm (3.15 inches). The peak pressure in the shoe press preferably is greater than about 2 MPa (col. 17, lines 1-3). Because greater than about 2 MPa is a preferred peak pressure, the reference would have fairly suggested, to one of ordinary skill in the art, a pressure somewhat outside the preferred range, such as about 2 MPa, which falls within the appellants' recited range. Edwards would have fairly suggested, to one of ordinary skill in the art, use of the full ranges disclosed, including the portions which overlap those of the appellants. See *In re Malagari*, 499 F.2d 1297, 1303, 182 USPQ 549, 553 (CCPA 1974).

The appellants argue that Edwards "provides no teaching or suggestion for operation below the disclosed minimum peak pressure of 2000 kN/m²" (reply brief, page 3). That argument is

not persuasive even if it is correct, because a peak pressure of 2000 kN/m² (2 MPa) falls within the appellants' recited range of less than or equal to approximately 2 MPa.

The appellants argue that Edwards would not have enabled one of ordinary skill in the art to make the claimed machine without undue experimentation (reply brief, pages 3-5). The appellants provide no evidence or reasoning in support of that argument, and there is no apparent reason why one of ordinary skill in the art would not have been able, through no more than routine experimentation, to use the full range of Edwards' press nip lengths and maximum pressing pressures.

We therefore conclude that the machine claimed in the appellants' claim 1 would have been obvious to one of ordinary skill in the art over Edwards.

Remand

We remand the application to the examiner to address on the record whether the machine claimed in the appellants' claims 2-33 would have been *prima facie* obvious to one of ordinary skill in the art over Edwards, alone or in combination with the additional references applied in the examiner's rejections and/or other prior art.

DECISION

The rejections of claims 1-4, 7-21 and 24-32 under 35 U.S.C. § 102(e) over Edwards, claims 5 and 6 under 35 U.S.C. § 103 over Edwards in view of Laapotti, claims 22 and 23 under 35 U.S.C. § 103 over Edwards in view of Bluhm and Tapiro, and claim 33 under 35 U.S.C. § 103 over Edwards in view of Sauer, are reversed. A new rejection of claim 1 has been entered under 37 CFR § 41.50(b), and the application is remanded to the examiner to address claims 2-33.

This decision contains a new ground of rejection pursuant to 37 CFR § 41.50(b) (effective September 13, 2004, 69 Fed. Reg. 49960 (August 12, 2004), 1286 Off. Gaz. Pat. Office 21 (September 7, 2004)). 37 CFR § 41.50(b) provides "[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review."

37 CFR § 41.50(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

- (1) *Reopen prosecution.* Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner.

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(2) *Request rehearing.* Request that the proceeding be reheard under § 41.52 by the Board upon the same record. . . .

REVERSED and REMANDED, 37 CFR § 41.50(b)

Terry J. Owens

TERRY J. OWENS
Administrative Patent Judge

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) BOARD OF PATENT
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Administrative Patent Judge

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Linda M. Gaudette

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